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Art Unit: 2623

**REMARKS****BEST AVAILABLE COPY**

This is a full and timely response to the outstanding final Office Action mailed May 2, 2006. Through this response, Applicant has amended claims 105-106, 122-127, and 128-133, and has added claims 134-139. Reconsideration and allowance of the application and pending claims 105-106, 108-115, and 122-139 are respectfully requested.

**I. Claim Rejections - 35 U.S.C. § 103(a)****A. Statement of the Rejection**

Claims 105-106, 108-115, and 122-133 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Ellis et al.* ("Ellis," U.S. Pat. No. 6,898,762 B2) in view of *LaRocca et al.* ("LaRocca," U.S. Pat. No. 6,314,572 B1). Applicant believes the rejections to be rendered moot in view of the claim amendments, and thus requests that the rejection be withdrawn. Applicant addresses below the patentability of the amended claims in view of the obviousness rejection from the final Office Action.

**B. Discussion of the Rejection**

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143

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discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, it is respectfully submitted that the presently pending claims are allowable over the art of record.

#### Independent Claim 105

Claim 105 recites (with emphasis added):

105. A method implemented by a television set-top terminal (STT) configured to provide television programs and a viewer's preference for advertisement categories, the method comprising:

- receiving by a tuner in the STT at least one television program;
- outputting to a television by the STT the at least one television program;

- outputting to a television by the STT a graphical user interface (GUI) that comprises a menu having a plurality of viewer selectable advertisement categories*, said plurality of viewer selectable advertisement categories including a first advertisement category and a second advertisement category that is different from the first advertisement category;

- receiving by the STT a first viewer input corresponding to the first advertisement category and a second viewer input corresponding to the second advertisement category;

- responsive to receiving the first and second viewer inputs, storing the first and second advertisement categories in the memory of the STT configured to store the viewer's preference for advertisement categories;

- outputting to the television by the STT an advertisement based on the stored advertisement categories*, wherein the advertisement is output by the STT at a future time during an interruption in the presentation of the at least one television program being output by the STT.

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Applicant respectfully submits that *Ellis* in view of *LaRocca* fails to disclose, teach, or suggest at least the above-emphasized claim features. The Office Action appears to alternately ascribe two distinct features in *Ellis* to the claim feature *selectable advertisement categories*. An explanation supporting one of these ascribed features is provided on page 6 of the Office Action, and reproduced below as follows:

In interactive EPG, the examiner would like to emphasize that the headend or service provider can be regarded as "a vendor" for advertising their products and/or programs because of a simple reason, the user or client or subscriber can choose which one to watch for their preference and the corresponding charge for that program, i.e., pay-per-view or interactive services such as online ordering or e-mails etc. That is why the reasons the examiner points out to program guide menu to selectable categories as "Movies," "Sports," "Children" and mentioned in the previous office action that the user/subscriber can select which category to view/watch according to their preference. Those programs are considered to be "selectable advertisement categories" or this reason.

The Manual of Patent Examining Procedure (MPEP), Section 2141, provides that when "applying 35 U.S.C. 103, the following tenets of patent law must be adhered to...(B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention." *Ellis* provides the following description of the program guide features 106 in column 10, lines 2-28:

"The program guide may provide users with an opportunity to access program guide features through a main menu. A main menu screen, such as illustrative main menu screen 100 of FIG. 5, may include menu 102 of selectable program guide features 106. If desired, program guide features 106 may be organized according to feature type. *In menu 102, for example, program guide features 106 have been organized into three columns. The column labeled "TV GUIDE" is for listings related features, the column labeled "MSO SHOWCASE" is for multiple system operator (MSO) related features, and the column labeled "VIEWER SERVICES"*

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*is for viewer related features.* The interactive television program guide may generate a display screen for a particular program guide feature when a user selects that feature from menu 102. Main menu screen 100 may include one or more selectable advertisements 108. Selectable advertisements 108 may, for example, include text and graphics advertising pay-per-view programs or other programs or products. *When a user selects a selectable advertisement 108, the program guide may display information (e.g., pay-per-view information) or take other actions related to the content of the advertisement.* Pure text advertisements may be presented, if desired, as illustrated by selectable advertisement banner 110.”

Clearly, *Ellis* distinguishes between selectable advertisement 108 and selectable program guide features 106. That is, nothing in *Ellis* discloses, teaches, or suggests that the program guide features 106 is the same or similar to *selectable advertisement categories*. Rather, Applicant respectfully submits that ascribing selectable program features 106 to *selectable advertisement categories* fails to consider *Ellis* as a whole and also appears to be an interpretation improperly derived from the benefit of Applicant’s claims.

Further, even assuming *arguendo* that “selectable program features” constituted *selectable advertisement categories*, Applicant respectfully submits that the “selectable program features” does not constitute *a menu having a plurality of viewer selectable advertisement categories*.

With regard to the ascribing of the alternate feature of *Ellis* to *selectable advertisement categories*, the Office Action provides on page 6 the following explanation:

Even if applicants do not agree on this, selectable buttons on items 108 (2 selectable buttons) and one on selectable advertisement banner 110 reads on this feature as well, refer to col. 10, lines 18-27. There is no reason to believe that those three selectable advertisements do not describe different advertisement categories, because it clearly suggests that pay-per-views and/or other programs and/or other products as well as text description is

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advertised on 110. For example, if the first box shows a movies[sic] for advertisement, the second one is for sports and the third box is for an incoming program or event. Thus, they are all advertising for different categories, the second is different from the first and/or the third.

Applicant respectfully submits that the "selectable buttons" described in the final Office Action do not constitute *a menu having a plurality of viewer selectable advertisement categories*. Accordingly, Applicant respectfully submits that claim 105 is patentable over *Ellis* in view of *LaRocca*, and respectfully requests allowance of claim 105.

Because independent claim 1 is allowable over *Ellis* in view of *LaRocca*, dependent claims 106, 108-115, and 134-135 are allowable as a matter of law for at least the reason that the dependent claims 106, 108-115, and 134-135 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

#### Independent Claim 122

Claim 122 recites (with emphasis added):

122. A television set-top terminal (STT) system, comprising:

*STT logic configured to output to a television a graphical user interface (GUI) that comprises a menu having a plurality of selectable advertisement categories*, receive a plurality of viewer inputs respectively corresponding to selections made from the menu having the plurality of selectable advertisement categories, responsive to receiving the plurality of viewer inputs, store in a memory of the STT the viewer-selected advertisement categories, and *after receiving the plurality of viewer inputs, receive advertisement data components corresponding exclusively to respective advertisements corresponding to the viewer selected advertisement categories*.

For similar reasons presented above in association with claim 105, Applicant respectfully submits that *Ellis* in view of *LaRocca* fails to disclose, teach, or suggest at least the above-

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emphasized claim features. Accordingly, Applicant respectfully submits that claim 122 is patentable over *Ellis* in view of *LaRocca*, and respectfully requests allowance of claim 122.

Because independent claim 122 is allowable over *Ellis* in view of *LaRocca*, dependent claims 123-127 and 136-137 are allowable as a matter of law.

#### Independent Claim 128

Claim 128 recites (with emphasis added):

128. A method implemented by a television set-top terminal (STT), comprising:

*outputting to a television by the STT a graphical user interface (GUI) that comprises a menu having a plurality of viewer-selectable advertisement categories;*

receiving by the STT a plurality of viewer inputs respectively corresponding to viewer-selected advertisement categories from the plurality of selectable advertisement categories, wherein the viewer inputs are provided by a viewer of the television; and

*responsive to receiving the plurality of viewer inputs, outputting to the television by the STT a plurality of commercials respectively corresponding to at least one of the viewer-selected advertisement categories.*

For similar reasons presented above in association with claim 105, Applicant respectfully submits that *Ellis* in view of *LaRocca* fails to disclose, teach, or suggest at least the above-emphasized claim features.

Additionally, Applicant respectfully submits that *Ellis* in view of *LaRocca* does not disclose, teach, or suggest *responsive to receiving the plurality of viewer inputs, outputting to the television by the STT a plurality of commercials*. Accordingly, Applicant respectfully submits that claim 128 is patentable over *Ellis* in view of *LaRocca*, and respectfully requests allowance of claim 128.

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Because independent claim 128 is allowable over *Ellis* in view of *LaRocca*, dependent claims 129-133 and 138-139 are allowable as a matter of law.

## II. New Claims

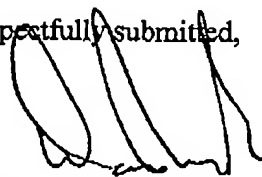
As identified above, claims 134-139 have been added into the application through this Response. Applicant respectfully submits that these new claims describe an invention novel and unobvious in view of the prior art of record and, therefore, respectfully request that these claims be held to be allowable.

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**CONCLUSION**

Applicant respectfully submit that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, and similarly interpreted statements, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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